

OFFICIAL

OFFICIAL

OFFICIAL

PATENT

Our Docket: P-HP 3808

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of  
Watson-Straughan et al.

Serial No: 09/632,928

Filed: August 4, 2000

For: TRIAMINE DERIVATIVE  
MELANOCORTIN RECEPTOR  
LIGANDS AND METHODS  
OF USING SAME

Commissioner for Patents  
Washington, D.C. 20231

) Group Art Unit: 1621

) Examiner: S. Barts

) I hereby certify that this correspondence  
) is being transmitted with the United  
) States Patent and Trademark Office by  
) facsimile on February 15, 2002.

By: David I. Spolter  
David I. Spolter, Reg. No. 36,933

February 15, 2002  
Date of Signature

RESPONSE TO OFFICE ACTION

Responsive to the Office Action mailed October 15, 2001, entry of the following Remarks is respectfully requested. A response was initially due by November 15, 2001. However, a petition for extension, requesting an extension of three months, or until February 15, 2002, along with the corresponding extension fee, is submitted herewith. Accordingly, this response is timely filed.

Response to Office Action  
App. Ser. No. 09/632,928  
Page 2

Regarding the restriction requirement.

The Action restricts the claims into two groups:

I. Claims 1 to 19 and 42, directed to compounds; and

II. Claims 20 to 41, directed to methods of treatment.

In response to the restriction, Applicants elect Group I, claims 1 to 19 and 42, directed to compounds.

However, Applicant respectfully traverses the restriction and request that Groups I and II be rejoined.

Citing MPEP sec. 806.05(h), the Office Action alleges that the claimed product can be used in a materially different process of using that product. However, MPEP sec. 806.05(h) also states that "The burden is on the examiner to provide an example" of such a method. The Office Action provides no such example. Accordingly, no proper basis for the restriction is provided and, therefore, rejoinder of Groups I and II are respectfully requested.

Alternatively, because no example of a materially different method is provided in the Action, as it must, Applicants respectfully request that one method be rejoined with the elected Group I of compounds. Specifically,

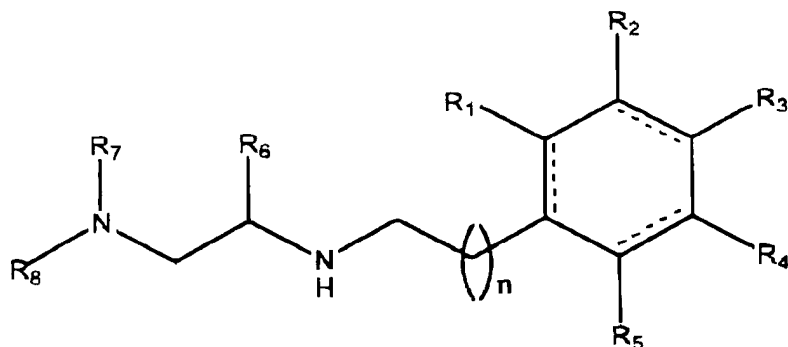
Response to Office Action  
 App. Ser. No. 09/632,928  
 Page 3

Applicants requests rejoining the claims directed to methods of altering the activity of a melanocortin receptor, claims 20 to 30.

**Regarding the species election.**

Having elected, with traverse, Group I for examination, the Office Action requests election of a species.

In response, Applicants elect a compound with the formula shown in claim 1,



wherein:

$R_1$ ,  $R_2$ ,  $R_4$ ,  $R_5$  and  $R_7$  are hydrogen;

$R_3$  is chloro;

$R_6$  is (4-iodophenyl)methyl;

Response to Office Action  
App. Ser. No. 09/632,928  
Page 4

R<sub>8</sub> is the formula X-CH-Y, wherein the adjoining nitrogen depicted in the formula of claim 1 is directly attached to the carbon atom of the formula X-CH-Y, and wherein:

X is 3-guanidinopropyl; and

Y is aminomethyl; and

n is 1.

# CONCLUSION

In light of the Remarks herein, Applicants respectfully submit that the claims are now in condition for allowance and requests a notice to this effect. Should the Examiner have any questions, he is invited to call the undersigned attorney.

Respectfully submitted,

Date: February 15, 2002

David I. Spolter  
David I. Spolter  
Registration No. 36,933  
Telephone No. (858) 459-2934  
Facsimile No. (858) 459-0698

LAW OFFICE OF DAVID SPOLTER  
1590 Coast Walk  
La Jolla, California 92037